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| 10/826,968      | 04/15/2004  | Stephen Alan Smith   | 3177 P 408          | 1182             |

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| EXAMINER |
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SMALLEY, JAMES N

| ART UNIT | PAPER NUMBER |
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3727

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/826,968

Applicant(s)

SMITH, STEPHEN ALAN

Examiner

James N. Smalley

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 01/31/05; 07/19/04
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

**DETAILED ACTION*****Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the embodiment of claims 19-20, comprising two retaining elements, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Elfelt et al. US 3,994,411.

Elfelt '411 teaches a container lid comprising a body having a recessed top wall (14) capable of receiving a user's top lip, an opening, a retaining element formed of slits (27) and (28), spaced

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approximately 90 degrees from the opening, and a closure (22) member affixed to the lid, moveable between a first position to obstruct the opening, and a second position received by the retaining element.

4. Claims 8, 12-13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by DeParales et al. US 4,202,459.

DeParales '459 teaches a coffee lid (11) comprising a body having a recessed top wall capable of receiving a user's top lip, an opening (16), a retaining element (19) positioned 180 degrees from the opening, and a closure (17) member affixed to the lid, moveable between a first position to obstruct the opening, and a second position received by the retaining element.

Regarding claim 8, Examiner notes the end of the retaining element (19) is spaced approximately 45 degrees from the opening, measuring from the arc endpoints of each element. Regarding claim 12, Examiner reads the relationship to comprise 180 degrees, measured from the center point of each element relative to the other.

5. Claims 12-13 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Turner US 4,949,865.

Turner '865 teaches a container lid, comprising a body having a recessed top wall (16) capable of receiving a user's top lip, an opening (22), a retaining element (20) positioned 180 degrees from the opening, and a closure (28) member affixed to the lid, moveable between a first position to obstruct the opening, and a second position received by the retaining element.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geren US 4,703,873 in view of JP 2000-159254.

Geren '873 teaches a lid comprising an opening (22) and a closure element (30) affixed to the body.

Geren '873 does not teach a retaining element.

JP '254, figure 7, teaches it is known to provide a container lid (22) with a retaining element (21) to secure a closure element (26).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lid of Geren '873, providing a retaining element, as taught by JP '254, motivated by the benefit of providing a location to secure the closure element when it is not being used.

Furthermore, Geren '873, as modified, does not teach locating the retaining element 45 degrees, or 90 degrees, from the opening.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the closure lid of Geren '873, locating the retaining element 45 degrees, 90 degrees, or any other arcuate distance from the opening, because it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claims 2, 9 and 17, Geren '873 does not teach a plug.

JP '254, figure 2, teaches a plug (6b) in the closure element.

It would have been obvious to one having ordinary skill in the art at the time the invention was to modify the closure element of Geren '873, providing the plug taught by JP '254, motivated by the benefit of sealing the opening.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759

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F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 8 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 17, 31, and 33-35 of U.S. Patent No. 6,679,397.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill to locate the retaining member in each of the '397 patent claims to 45 degrees away from the opening, to 90 degrees away from the opening, or to any other angular relationship, as claimed in the instant claims, because such is an obvious change in the location of the working parts of the invention. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

10. Claim 5 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,679,397.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill to locate the retaining member of the '397 patent to 45 degrees away from the opening, to 90 degrees away from the opening, or to any other angular relationship, because such is an obvious change in the location of the working parts of the invention. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

11. Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 6,679,397.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill to locate the retaining member of the '397 to 45 degrees away from the opening, to 90 degrees away from the opening, or to any other angular relationship, because such is an obvious change in the location of the working parts of the invention. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

12. Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,679,397.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill to locate the retaining member of the '397 to 45 degrees away from the opening, to 90 degrees away from the opening, or to any other angular relationship, because such is an obvious change in the location of the working parts of the invention. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

13. Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 32 of U.S. Patent No. 6,679,397.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the closure element affixed to the body is not patentably distinct from an arm with a plug, and furthermore the claims comprise overlapping ranges, whereby "proximately 180 degrees from the opening" as claimed in the '397 patent is within "between 90 and 180 degrees" of the instant claim 16.

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14. Claim 5 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 11 of copending Application No. 10/641,498.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to position the retaining element of claim 3 of the '498 application 90 degrees away from the drink opening, or to any other location, because such is an obvious change in the location of the working parts of the invention. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claim 16 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 16 of copending Application No. 10/641,498.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to position the retaining element of claim 16 of the '498 application 90 degrees away from the drink opening, or to any other location, because such is an obvious change in the location of the working parts of the invention. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claim 18 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 11 of copending Application No. 10/641,498.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the opposed positional relationship of the '498 application is read to be the "obtuse angle" in claim 13 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



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**Conclusion**


17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:  
See attached PTO-892 teaching various beverage container covers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N. Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on M-Th 9-6:30, Alternate Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jns

  
**NATHAN J. NEWHOUSE**  
**PRIMARY EXAMINER**